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| 10/633,772 | 08/04/2003 | Elinor Isobel Forbes | MS-02/3/US | 5121 |

7590 09/26/2008
James C. Forbes
101 Pointe Drive, #403
Northbrook, IL 60062

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| EXAMINER |
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MUSSELMAN, TIMOTHY A

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| ART UNIT | PAPER NUMBER |
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3714

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09/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/633,772 | Applicant(s) FORBES ET AL. | |
| | Examiner TIMOTHY MUSSELMAN | Art Unit 3714 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

In response to the communication dated 4/15/2008, claims 21-38 are pending in this application. Claims 1-20 have been cancelled previously.

Claim Rejections - 35 USC § 103

The following is a quotation of the relevant portion of 35 U.S.C. 103 that forms the basis for the rejections made in this section of the office action;

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Claims 21, 26, and 32-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Everett (WO99/56844) in view of Cohen et al. (US 3,726,027).

Regarding claims 21, 26, and 32-38, applicant has claimed a method comprising precisely two steps.

The first method step is to provide a kit to an adult subject with dementia, and the second step is to encourage the subject to assemble the kit. The remainder of claim 21 pertains to structural limitations of the kit for assembly.

Providing kits for adult sufferers of dementia for assembly is old and well known in the art. See Everett, col. 2: 18-48, wherein Everett discloses the need for providing games to a subject with dementia for therapy (enjoyment and stimulation are consistent with applicant's definition of therapy from pages 5-6 of the specification). Everett further discloses wherein the provided game is a kit is for assembly. See col. 5: 29-43.

In light of Everett's establishment that both steps of applicant's method are old and well known in the art, it is the position of the office that the substitution of alternative kits known in the art would have been obvious to one of ordinary skill in the art at the time of the invention whether or not those kits were designed for the purpose of therapy for dementia sufferers. This is so because Everett has already established applicant's method steps of providing kits for use by dementia subjects, and further because none of applicant's structural limitations are novel. Rather, applicant's structural limitations are merely a combination of elements known in the art of assembly kits and puzzle/game type devices, and thus the combination of these various structural limitations combined broadly with the disclosure by Everett that it is known to provide kits to subjects with dementia would merely be a combination of elements known in the art, and no unexpected results would ensue, as the established result of such activities at the time of applicant's invention was already well known to be therapeutic value. As further evidence consider the disclosure by Dondero (US 5,538,432) that it is old and well known to provide Dementia subjects with pastimes involving the distinguishing of colors, shapes, and textures for stimulation (i.e. therapy). See col. 1: 29-44. With the aforementioned reasons for obviousness in mind, the structural elements of applicant's invention will now be addressed broadly.

Everett discloses placing pieces on a rack wherein they resist accidental disarrangement. See col. 5: 29-36. This is also the limitation of claims 26.

Everett discloses wherein the pieces have multiple sides. See fig. 1B labels 7 and 8. Everett does not teach wherein the pieces are covered in various soft fabrics of differing tactility (individually and on different sides of a single piece). However, Cohen discloses that this concept is old and well known in the art of puzzle type pastimes. See col. 3: 53-62 and col. 4: 11-25, and note that the pieces can be flannel or fur (claims 32-28). It would have been obvious to include this feature in the therapeutic method of Everett because it would merely be using known characteristics of puzzle pastimes in a known method of presenting such pastimes to dementia subjects for therapy.

Claims 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Everett (WO99/56844) in view of Cohen et al. (US 3,726,027) and in view Ostrar et al. (US 5,738,559).

Regarding claims 22-25, applicant is claiming a fabric patchwork kit. This type of kit is old and well known in the art. For example, Ostrar discloses just such a kit. See col. 2: 1-45, wherein the creation of a patchwork hand puppet is disclosed, that involves the combination of at least two fabric elements together by use of lacing (without needles for safety and ease). It would have been obvious to include this kit in the therapeutic method of Everett because it would merely be using a known type of kit in a known method of presenting such kits to dementia subjects for therapy.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Everett (WO99/56844) in view of Cohen et al. (US 3,726,027) and in view of Lockhart et al. (US Des. 277,492).

Regarding claim 27, applicant is claiming a standard jigsaw type puzzle (similar to fig. 6 of applicants spec). This type of kit is old and well known in the art, as shown for example in the design patent to Lockhart et al. in fig. 1, which shows a puzzle comprising multiple pieces which reside inside a single aperture in a tray when completed properly. It would have been obvious to include this kit in the therapeutic method of Everett because it would merely be using a known type of kit in a known method of presenting kits to dementia subjects for therapy.

Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Everett (WO99/56844) in view of Cohen et al. (US 3,726,027) and in view of Studen (US 3,280,499).

Regarding claims 28 and 29, applicant is claiming the use of a kit comprising apertures specifically sized to fit specific pieces. This type of puzzle is old and well known in the art, and can be seen in Studen, fig. 2. It would have been obvious to include this kit in the therapeutic method of Everett because it would

Art Unit: 3714

merely be using a known type of kit in a known method of presenting kits to dementia subjects for therapy.

Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over (WO99/56844) in view of Cohen et al. (US 3,726,027) and in view of Kemnitzer (US 3,849,912) and Ostrar (US 5,738,559).

Regarding claims 30 and 31, applicant is claiming the use of a kit comprising a pegboard for placing fabric patches with multiple eyelets. Kemnitzer discloses a kit for placing objects comprising multiple eyelets onto a pegboard. See fig. 1. However, there is no teaching wherein the pieces are fabric. Yet, fabric pieces for assembly kits are old and well known in the art. Recall the reference to Ostrar that utilized the fabric pieces of the puppet kit, as described in col. 2: 1-45. It would have been obvious to include these kit features from Kemnitzer and Ostrar in the therapeutic method of Everett, because it would merely be using known kits and variations thereof in a known method of presenting kits to dementia subjects for therapy.

Response to Arguments

Applicant's arguments dated 4/15/2008 have been fully considered. With regard to the date issue of the Everett reference (US 6,398,222), the subject matter was publicly available with the publication of the accompanying international application (WO99/56844) on 11/11/1999. This international application is available as prior art under 35 U.S.C. 102(b), because the publication date of the application predates the filing date of the instant application (8/4/03) by more than one year, and the reference was publicly available before applicant's earliest priority date of 9/9/2000. As can be seen in the included WIPO publication WO/0956844 (retrieved from the WIPO website), the earlier WIPO publication contains the identical subject matter. Since the '222 patent is in this 'family' of patents, and clearly references the earlier WIPO publication confirmed as containing the identical subject matter, the '222 reference will be used to point out the subject matter in this rejection, if only for simplicity, since the WIPO publication is in

Art Unit: 3714

a considerably less convenient format for citations. Additionally, the double patenting rejection is withdrawn, because a terminal disclaimer has been previously filed. This rejection is thus made NON-FINAL.

Applicant's arguments regarding the allegation that Cohen does not provide pieces in a kit for arrangement are not persuasive, because the Cohen reference was not relied upon for this feature in the current rejection (the Everett reference contains this feature in at least col. 5:29-36). The Cohen reference was relied upon for the various textures known to be utilized in puzzle type pastimes.

Applicant argues that one of ordinary skill in the art would not be motivated to make the combination with Everett and Cohen (and the other combinations as well). All reference combination arguments will be addressed together here. Applicant argues that the combination of these references are not valid, because the rejections are overly broad. Examiner acknowledges that the rejections are broad in nature, but asserts that this rejection is proper. Everett discloses providing a kit to a subject with dementia, wherein the subject assembles the kit for therapeutic purposes. See col. 9: 29-36. Thus, applicant's method steps are disclosed clearly by Everett. Additionally, it is disclosed by Dondero (US 5,538,432) that it is old and well known to provide Dementia subjects with pastimes involving the distinguishing of colors, shapes, and textures for stimulation (i.e. therapy). These two references make it quite clear that it was known in the art to provide puzzle type devices to dementia subjects for therapeutic value. MPEP 2143 (A) states that it is valid to combine elements known in the art to achieve predictable results for a rejection under 35 U.S.C. 103. In light of the teachings of Everett (and also the evidence of Dondero), one of ordinary skill in the art would have been motivated to combine these known elements of puzzle type pastimes of various sorts, with the predictable result of providing therapeutic value (the predictable result being the therapeutic value itself, as taught by Everett and Dondero). Additionally, MPEP 2143 (E) states that a 35 U.S.C. 103(a) rejection can be made if it would have been "obvious to try" the combination. In light of the teachings of Everett and Dondero, it would have been "obvious to try" other puzzle type devices of various shapes and textures known in the art for the same purpose of providing therapy. While

Art Unit: 3714

this opens a broad field as prior art, examiner alleges that this is reasonable, because to *not* open up the field of pastimes containing puzzle and craft type devices of various shapes and textures would imply that *any* puzzle would be eligible for a patentable process simply by providing it to a person with dementia and telling them to use it in the manner already known for that particular device. It is the position of the office that obvious variations are to be expected on the themes established by the prior art of Everett and Dondero, and in this instance, puzzle type pastimes are a valid field of prior art because the use of these types of devices for therapeutic purposes has been clearly established by Everett and Dondero.

Applicant's arguments pertaining to safety issues of user's 'casting projectiles' in the Everett system are not persuasive, at least because the casting of the projectiles is not a required element of Dondero (users also place shaped pieces into matched apertures – col. 9:25-36). Applicant's arguments that Everett does not disclose a kit which is arranged by a user are not persuasive. Everett *clearly* discloses wherein separate pieces of a kit are arranged on a frame. See col. 5: 21-36 and figs 1A and 1B. Applicant's arguments that Lockhart does not show pieces arranged to fit together inside an aperture are not persuasive. Lockhart clearly shows a puzzle device wherein the pieces fit together to form a whole inside the single main aperture. See fig. 1.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy Musselman whose telephone number is (571)272-1814. The examiner can normally be reached on Mon-Thu 6:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571)272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. M./
Acting Examiner of Art Unit 3714

/Robert E Pezzuto/
Supervisory Primary Examiner
Art Unit 3714